

REMARKS

Claims 1-17 were examined and reported in the Office Action. Claims 1-4, 6-13 and 15-17 are rejected. Claim 14 is allowed. Claims 1, 4, 13 and 15-17 are amended. Claims 1-17 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. 35 U.S.C. § 103(a)

It is asserted in the Office Action that claims 1-4, 6-13, and 15-17 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over U. S. Patent No. 4,504,310 issued to Boulier (“Boulier”) in view of U. S. Patent 6,695,960 issued to Bacos et al (“Bacos”). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2142

[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that ‘rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Further, according to MPEP §2143, “[T]he Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1395-1397 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*.” Further, according to MPEP §2143.01, [o]bviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Further, “[t]he

mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007).

Additionally,

[a] statement that modification of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Pat. App. & Inter. 1993).

It is asserted in the Office Action that Boulier does not disclose eliminating a surface layer from the final product. Applicant agrees. It is further asserted in the Office Action that “one skilled in the art intending to produce delicate parts, would be required to perform steps such as surface finishing in order to ensure that any such parts are produced within very close tolerances.” Applicant respectfully disagrees. Applicant’s claims do not relate to delicate parts. In order for Applicant’s metal granules to become delicate parts, the granules would need to be melted and cast. Therefore, there is no need for Applicant’s granules to comply with close tolerances or to have a bright aspect because these properties will disappear when the granules are melted for casting metal parts.

The main requirement concerning Applicant’s quality of the granules is the composition, especially the purity. According to Applicant’s specification, the significant improvement of the purity of the granules is due to the elimination of a surface layer, as was unexpectedly found by Applicant (see Applicant’s specification, paragraph [0016]).

Bacos is relied on for disclosing it was known in the art to subject metal particles to post-operative machining followed by tribofinishing. In Bacos, the products are not metal granules but alloy coatings that are intended to be projected on delicate parts in order to protect the parts (Bacos, column 1, lines 18-29). Therefore, the requirements for such coatings are not the same as for the granules that will be used to manufacture delicate parts. Also, Bacos does not solve the same problem as in Boulier. In Bacos, the need for tribofinishing is due to the fact that the

Bacos coatings are rough (see Bacos, column 2, line 31). Applicant acknowledges that tribofinishing was a known technique at the time of filing the application, but the known tribofinishing technique was known as a finishing step for improving the surface of parts, especially cast metal parts. Applicant's claimed invention, however, uses tribofinishing for improving the purity of metal granules, which is not known or obvious to an ordinary person skilled in the art at the time of invention.

Even if Boulrier is combined with Bacos, the resulting invention would fail to teach or suggest "purifying the granules by eliminating a surface layer from the granules, wherein the surface layer contains a greater concentration of impurities than a center of the granules." Further, the assertions made in the Office Action on page 3 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP 2143 cannot be found. Additionally, since neither Boulrier, Bacos, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's amended claims 1, 13 and 15-17, as listed above, Applicant's amended claims 1, 13 and 15-17 are not obvious over Boulrier in view of Bacos since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claim 1, namely claims 2-4 and 6-12, would also not be obvious over Boulrier in view of Bacos for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 1-4, 6-13, and 15-17 are respectfully requested.

II. Allowable Subject Matter

Applicant notes with appreciation the Examiner's assertion that claim 14 is allowable over the prior art of record.

Applicant respectfully asserts that claims 1-17, as they now stand, are allowable for the reasons given above.

CONCLUSION

In view of the foregoing, it is submitted that claims 1-17 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

PETITION FOR EXTENSION OF TIME

Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on August 23, 2007, Applicant respectfully petitions the Commissioner for a one (1) month extension of time, extending the period for response to December 23, 2007. The Commissioner is hereby authorized to charge payment to Deposit Account No. 02-2666 in the amount of \$120.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(1) large entity. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: November 27, 2007

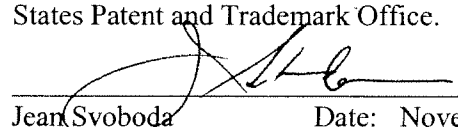
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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below to the United States Patent and Trademark Office.


Jean Svoboda

Date: November 27, 2007